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*SW*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,873	08/22/2003	Robert L. Doubler	2131.022	3190

21917 7590 12/01/2004

MCHALE & SLAVIN, P.A.

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EXAMINER

STEWART, ALVIN J

ART UNIT PAPER NUMBER

3738

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/647,873	Applicant(s) DOUBLER ET AL.	
	Examiner Alvin J Stewart	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/11/03</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the annular skirt (claim 9) should be shown in the specification.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I order to clarify claim 9 the Applicant's representative should delete the following words:

"taper of said" and "whereby", in page 23, lines 5 & 6.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by White et al US Patent 5,902,340.

White et al discloses a modular implant (see Fig. 4) comprising a link (411 & 412), a weight bearing (120), an intramedullary rod (130), a tubular extension (see attachment A), a mouth, a blind bore (431) and an enlargement (411). The link has a proximal and distal ends (see attachment).

Regarding claims 5-7, see attachment B & C disclosing each structure limitation.

Claims 5, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Doubler et al US Patent 6,299,648 B1.

Doubler et al discloses a modular implant (see Fig. 1) comprising a link (13), a trochanter (16), an intramedullary rod (11), a tubular extension (28), a fastener (50), a neck (41), a skirt (31), a bore and a bore being countersunk (see attachment). The link has a proximal and distal ends (see attachment).

Regarding the sub-assembly being relatively movable, the link, the tubular extension and the intramedullary rod all are movable. The three structures above are capable of being moved at the same time. In order to overcome the rejection the Applicant's representative has to clarify the link and intramedullary rod are capable of move independently relative to each other.

Regarding claim 8, the link and the trochanter are non-rotationally connected when the bolt (50) is tightly connected with the rod.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doubler et al US Patent 6,299,648 B1 in view of Fernandez et al US Patent 6,319,286 B1.

Doubler et al discloses the invention substantially as claimed. However, Doubler et al does not disclose a tapered end portion in the trochanter and a tapered portion in the tubular extension that is complementary to the tapered end portion.

Fernandez et al teaches a modular hip prosthesis comprising a neck (12), a trochanter (14), and an intramedullary rod (16) having a tubular extension (43). The trochanter discloses a bore comprising a tapered end (14b, 34 & 34b, see col. 5, lines 9-12) and the tubular extension has a tapered surface (43a & 43b, see col. 5, lines 12-17) for the purpose of enhancing interchangeability of components and thereby, modularity of the prosthesis (see col. 5, lines 24-34).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Doubler et al reference with the tapered configuration of the Fernandez et al trochanter and tubular extension in order to enhance interchangeability of components and thereby, modularity of the prosthesis.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J Stewart whose telephone number is 703-305-0277. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3738

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*A. Stewart*

Alvin J Stewart  
Primary Examiner  
Art Unit 3738

November 24, 2004.

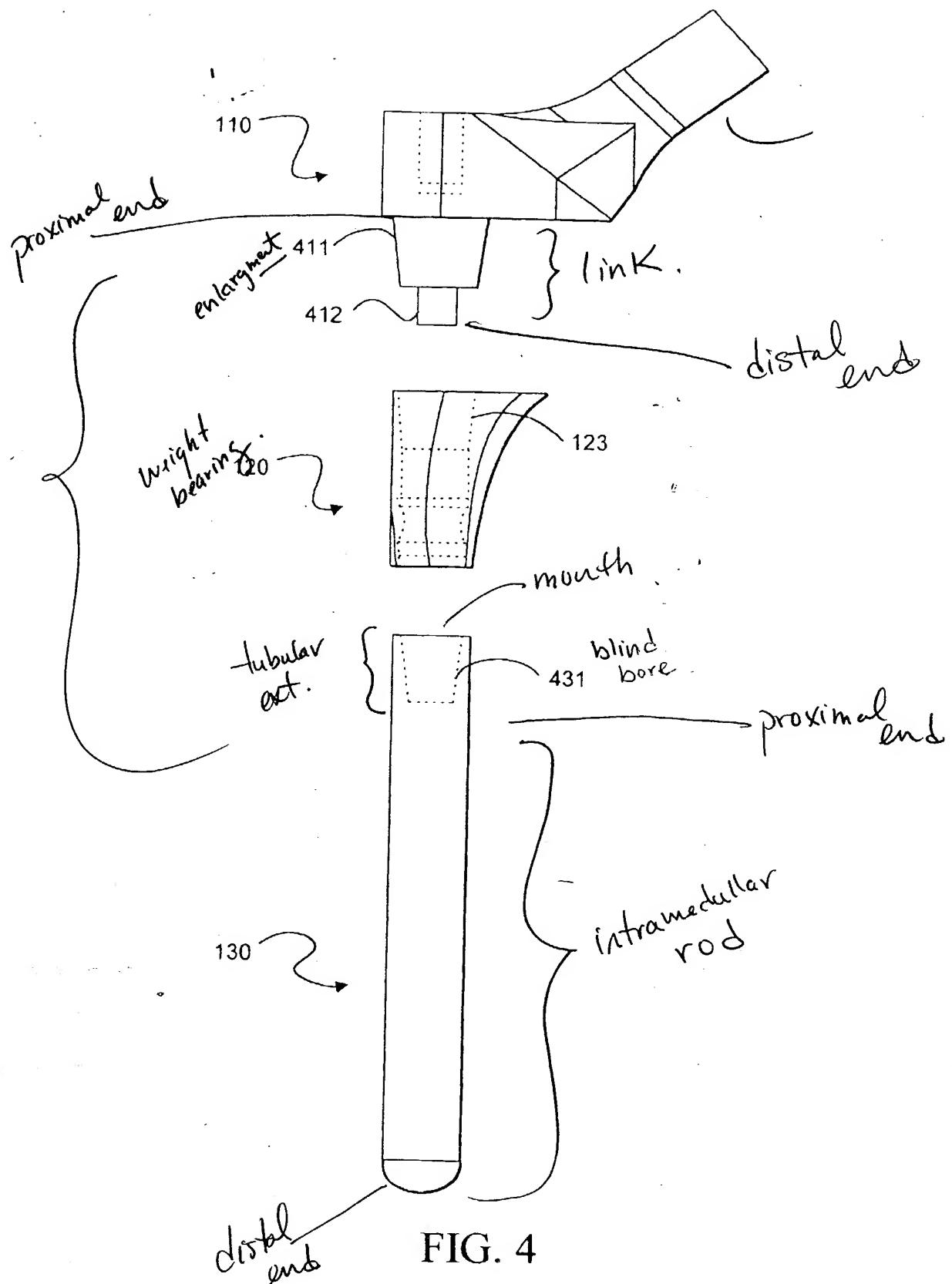


FIG. 4

# ATTACHMENT B

U.S. Patent

May 11, 1999

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5,902,340

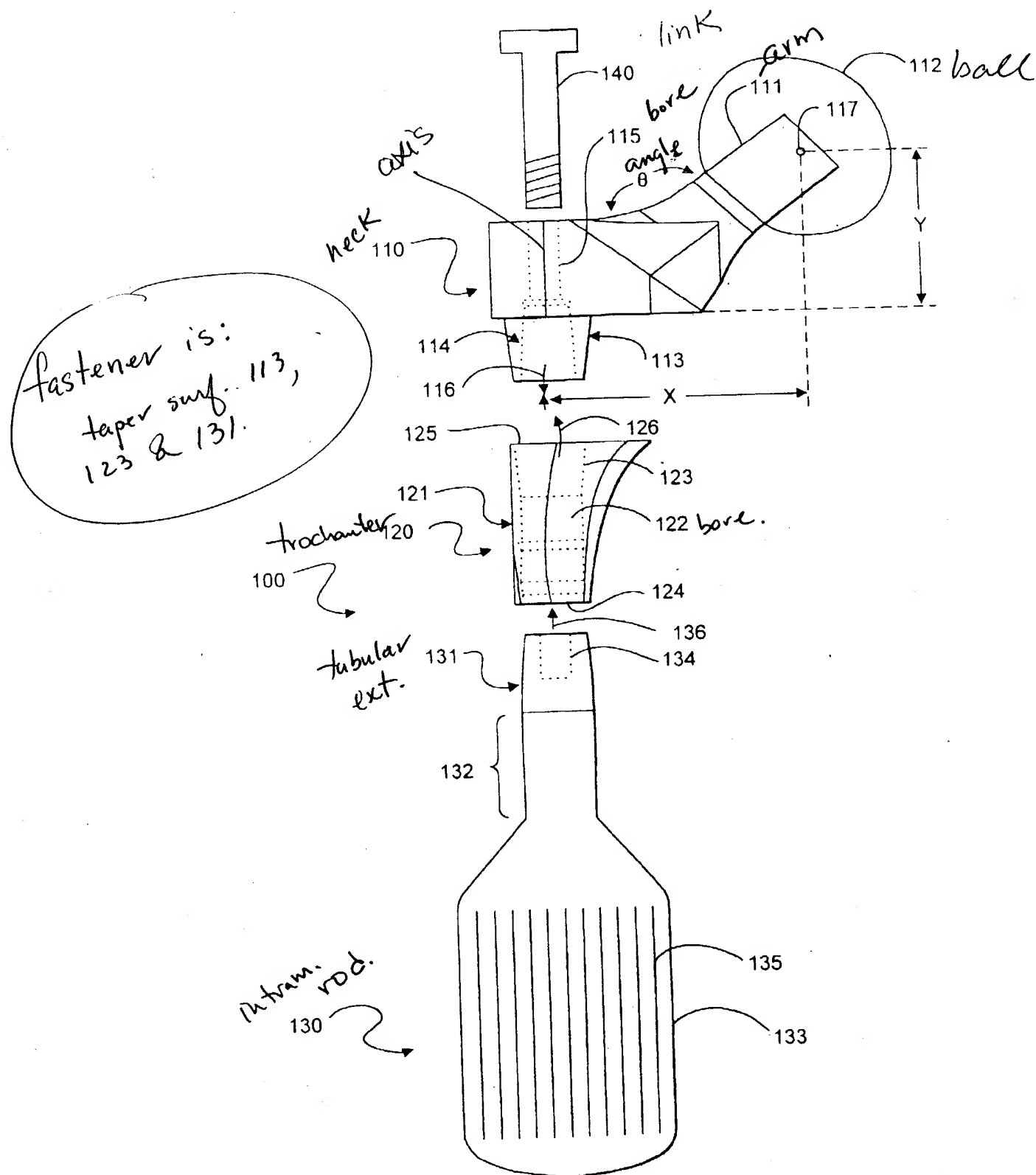


FIG. 1



# ATTACHMENT C

U.S. Patent

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5,902,340

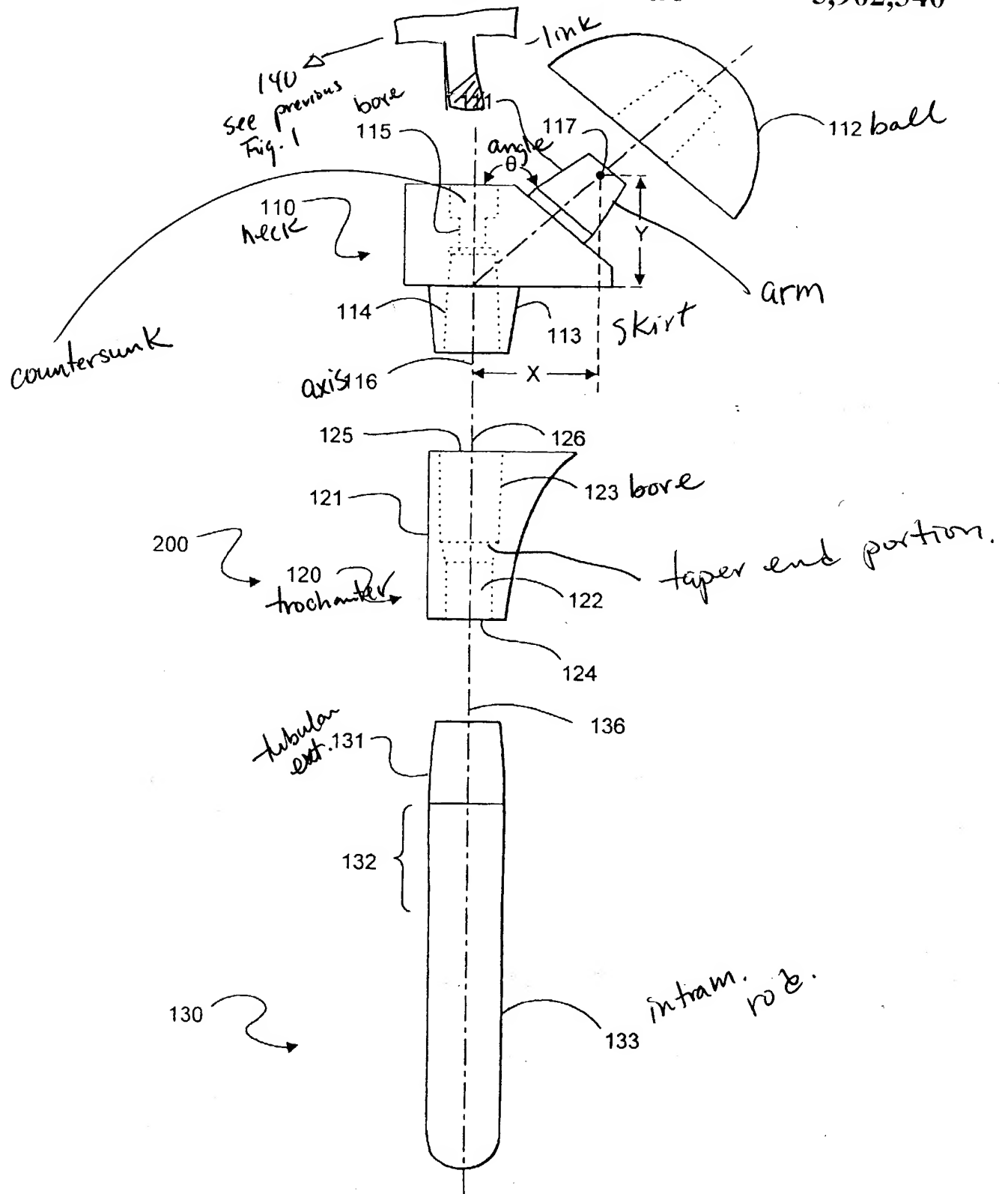


FIG. 2

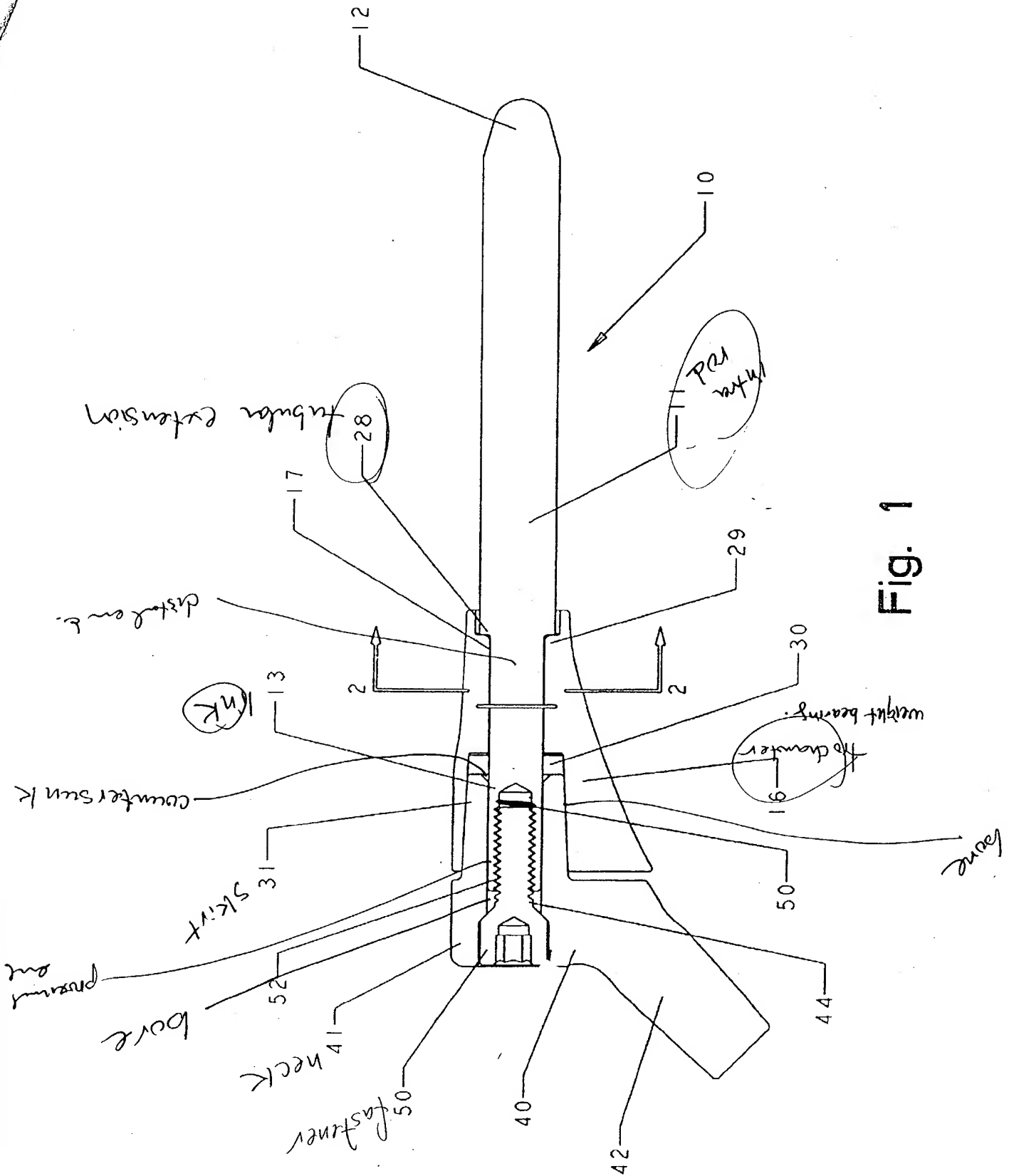
ATTACHMENT D

## U.S. Patent

**Oct. 9, 2001**

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US 6,299,648 B1



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